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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/081,739

02/21/2002

Walter Callen

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1077

45975 7590 03/13/2007

DIVERSA C/O MOFO S.D.  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

EXAMINER

RAO, MANJUNATH N

ART UNIT

PAPER NUMBER

1652

MAIL DATE

DELIVERY MODE

03/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/081,739

Applicant(s)

CALLEN ET AL.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See attached.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: see attached.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: See attached.  
Claim(s) withdrawn from consideration: See attached.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit: 1652

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*Advisory Action*

Claims 1-2, 6, 12, 16, 29, 47-62, 68-75, 87-88, 95-107, 111-115, 117-122, 130-152 are now currently pending in this application. Claims 1-2, 6, 12, 16, 29, 47-48, 74-75, 87-88, 101-106, 130-132 are now under consideration. Claims 49-62, 68-73, 95-100, 107, 111-115, 117-122, and 133-152 remain withdrawn from consideration as being drawn to non-elected invention.

Applicant's request for reconsideration filed on 2-21-07 has been considered and ENTERED. However, while the amendment has overcome some of the rejection, some claims are still not in condition for an allowance as explained below.

Amendments to claims have overcome the previous rejection held under 35 USC 112 1<sup>st</sup> paragraph for the issue of new matter. However, amendments to claims 74-75 has not overcome the rejection of claims 74-75, 87-88 under 35 USC 112, 1<sup>st</sup> paragraph for lack of enablement as well as written description. Therefore Examiner continues to maintain the previous rejections.

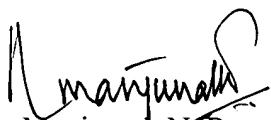
As indicated previously claims 1, 6, 12, 16, 29, 47-48 are allowable along with claims 2, 101-106, 131, 132. In view of the allowable product of claims 1 and 2, claims 68-70 are ready for rejoining. However, claims 49-62 and 130, even though drawn to the method of use of the polynucleotide are not ready for rejoining due to inherent problems with written description and enablement issues. Claim 49 lacks the function of the variant polynucleotide generated by the claimed method. Part (b) of claim 130 is still drawn to any "nucleic acid operably linked to a promoter". Therefore these method claims have not been perfected for rejoining and cannot be rejoined.

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Next, Examiner respectfully disagrees with the applicant's argument that all the remaining method claims also need to be rejoined with the allowed claims. This is because all remaining claims drawn to different methods are drawn primarily to the method of use of the polypeptide and NOT the polynucleotide even though the claims recite the polypeptide as that encoded by the polynucleotide indicated as allowable.

The rejection of claims 74-75, 87-88 are maintained for reason of record.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit 1652

March 12, 2007